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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,562	03/01/2004	Abraham Bout	2578-4038.3US	9903

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EXAMINER

SCHLAPKOHL, WALTER

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/790,562

Applicant(s)

BOUT ET AL.

Examiner

Walter Schlapkohl

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*waf*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 May 2006 and 27 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 7-30 is/are pending in the application.
- 4a) Of the above claim(s) 21-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 7-18 and 30 is/are rejected.
- 7) ☒ Claim(s) 19 and 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/26/2006</u> . | 6) <input type="checkbox"/> Other: _____  |

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#### **DETAILED ACTION**

Receipt is acknowledged of the papers filed 5/26/2006 in which claims 1, 8-10, 17 and 21 were amended, claims 2-6 were cancelled, and claim 30 was added. Receipt is also acknowledged of the papers filed 6/27/2006 in which replacement drawings were submitted. Claims 1 and 7-30 are pending. Claims 21-29 are withdrawn. Claims 1, 7-20 and 30 are under examination in the instant Office action.

#### ***Election/Restrictions***

Claims 11-16, drawn to non-elected species, have been rejoined. Claims 21-29 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 11/23/2005.

#### ***Information Disclosure Statement***

The information disclosure statement filed 5/26/2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be

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listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Examiner acknowledges Applicant's submission that the above-referenced IDS is in compliance with 37 CFR 1.98 and that Applicant believes that "[a]ll of the cited foreign patent documents and non-patent literature were previously submitted to the Office in the in the prior application Serial No.:

09/549,463, filed on September 3, 2002" (see page 39, 3<sup>rd</sup> full paragraph of the remarks filed 5/26/2006). However, Examiner has checked the file again and the documents listed on the IDS submitted 5/26/2005 are not present in the file for application 09/549,453. In fact, those documents were not cited on an IDS present in the 09/549,453 file. The Examiner notes for the record that said application was filed on 4/14/2000 and not on 9/3/2002 as Applicant asserts.

The information disclosure statement filed 5/26/2006 has been considered and the initialed copy of the IDS has been included in this Office action.

### ***Specification***

The amendments to the disclosure have been found remedial. The objection to the specification for the use of the trademark PER.C6<sup>TM</sup> is hereby WITHDRAWN.

### ***Claim Objections***

The objection to claims 8 and 17 for failing to spell out the acronyms "PGK" and "CMV" is hereby WITHDRAWN in view of Applicant's amendments.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9 and 11-15, and therefore dependent claim 16, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. **These are new rejections.**

Claim 9 contains the trademark/trade name PER.C6<sup>TM</sup>. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim

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does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a PER.C6 human embryonic retinoblast cell containing Ad5 E1A and E1B-encoding sequences under the control of the human PGK promoter and, accordingly, the identification/description is indefinite.

Claims 11-15 recite a "proteinaceous substance." Claims 11-15 are vague and indefinite in that it is unclear what the metes and bounds of a "proteinaceous substance" are. Does proteinaceous substance include only proteins, proteins comprising non-protein components, or substances that are similar to proteins?

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple

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assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 7-9 and 17-18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 25 and 30 of copending Application No. 10/499,298. **This provisional rejection is maintained for reasons of record explained in the previous Office action.**

Claims 1, 7-10, 17-18 and 30 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 28-29, 32-35 and 43 of copending

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Application No. 11/039,767. **This provisional rejection is maintained and extended to new claim 30 for reasons of record explained in the previous Office action.**

The provisional rejection of claims 1-10 and 17-18 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 37-39 of copending Application No. 10/497,832 is WITHDRAWN upon reconsideration of the reference claims by Examiner.

*Response to Arguments*

Receipt is acknowledged of the terminal disclaimer filed 5/26/2006. The terminal disclaimer is found ineffective with regard to overcoming the double patenting rejection of Application 10/499,298 because the terminal disclaimer recites "Application Number 10/449,298" (emphasis added) on lines 4-5 of the first paragraph. The terminal disclaimer does not recite and, therefore, does not apply to application number 11/039,767. Thus, the provisional rejections on the ground of nonstatutory double patenting cited above are maintained.

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***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The rejection of claims 1, 3-9 and 18 under 35 U.S.C. 102(b) as being anticipated by Fallaux et al (WO 97/00326) is hereby WITHDRAWN in view of Applicant's amendment(s).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The rejection of claims 1-10 and 17-20 under 35 U.S.C. 103(a) as being obvious over Fallaux et al (cited above) in view of Dorai et al (US Patent No. 5,631,158) is hereby WITHDRAWN in view of Applicant's amendment(s).

**Allowable Subject Matter**

Claims 19-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Conclusion**

No claim is allowed.

Certain papers related to this application may be submitted to the Art Unit 1636 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The official fax telephone number for the Group is (571) 273-8300. Note: If Applicant *does* submit a paper by fax, the original signed copy should be retained by Applicant or Applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-

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For all other customer support, please call the USPTO Call Center (UCC) at (800) 786-9199.

Any inquiry concerning rejections or objections in this communication or earlier communications from the examiner should be directed to Walter Schlapkohl whose telephone number is (571) 272-4439. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Remy Yucel can be reached at (571) 272-0781.

Walter A. Schlapkohl, Ph.D.  
Patent Examiner  
Art Unit 1636

September 7, 2006

  
NANCY VOGEL  
PRIMARY EXAMINER